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MAILED
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OFFICE OF PETITIONS

In re Application of :
Wood : DECISION ON APPLICATION
Application No. 10/634,701 : FOR PATENT TERM ADJUSTMENT
Filed: August 5, 2003 :
Attorney Docket No. RSW920030050US1 :

This is in response to the "Application for Patent Term Adjustment Including Request for Reconsideration of Patent Term Adjustment Indicated in Notice of Allowance (37 CFR §1.705)" filed October 9, 2009. Applicant requests the initial determination of patent term adjustment be corrected from one thousand ninety-five (1,095) days to one thousand one hundred forty (1,140) days.

The application for patent term adjustment is **dismissed**.

On September 24, 2009, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicant was advised of a patent term adjustment to date of 1,095 days. In response, applicant timely filed this application for patent term adjustment prior to payment of the issue fee.

Applicant requests the patent term adjustment be corrected to 1,140 days.

Applicant's request is based on an assertion the patent term adjustment should have included an additional 45 days for Office delay under 37 C.F.R. § 1.703(a)(3).

Relevant Background Facts

The Office issued a final Office action on February 9, 2009.

Applicant filed a reply including a Request for Continued Examination and amendment on April 10, 2009.

The Office issued a non-final Office action on June 25, 2009.

The examiner conducted a telephonic interview with Marcia Doubet, Applicant's representative, on August 24, 2009. The interview summary form prepared by the examiner states, with emphasis added,

Applicant's Representative called and informed Examiner that the Vaschillo reference was not available as a prior art reference due to its filing date. The Examiner agreed that an error had been made and *withdrew* the rejection of 25 June 2009.

The Office issued a Notice of Allowance and a copy of the interview summary form on September 24, 2009. The Notice of Allowance included the examiner's statements of reasons for allowance. The examiner stated,

Applicant's Representative (Marcia Doubet) noted that the Vachillo reference is not a valid prior art reference.... Therefore, the prior art does not teach the claimed features.... Furthermore, Applicant's arguments presented in the amendment filed 10 April 2009 are persuasive.

Applicant's Arguments

The Statement of Facts filed by applicant states, with emphasis omitted,

[The June 25, 2009] Non-final Rejection was void *ab initio*, due to reliance therein on a reference that did not qualify under 35 U.S.C. §102 or §103. Accordingly, the Non-Final Rejection was withdrawn/vacated by the Examiner....

Because the Non-Final Rejection mailed on June 25, 2009 was void *ab initio*, the Non-Final Rejection is considered not to have been mailed. Therefore, the appropriate time period for Patent Term Adjustment under §1.703(a)(2) begins on April 10, 2009, when the Amendment was filed and ends on September 25, 2009, when the Notice of Allowance was mailed. As noted above, this time period exceeds the four-month period set out in §1.703(a)(2) by 45 days.

Discussion

Applicant argues the June 25, 2009 Office action improperly relied on a reference that did not qualify under 35 U.S.C. §§ 102 or 103.

35 U.S.C. § 154(b)(1)(A)(ii) indicates an adjustment for Office delay is warranted if the Office fails to "respond to a reply under section 132 ... within 4 months after the date on which the reply was filed." The statute does not indicate the response must be "correct" or "error-free." In other words, the statute does not indicate an increase in patent term adjustment is warranted in the instant case.

37 C.F.R. § 1.703(a)(3) implements the requirement set forth in 35 U.S.C. 154(b)(1)(A)(ii).

Pursuant to 37 C.F.R. § 1.703(a)(3), the period of patent term adjustment includes, with emphasis added,

The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply in compliance with § 1.113(c) was filed and ending on the date of mailing of either *an action under 35 U.S.C. 132*, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

An increase in patent term adjustment under 37 C.F.R. § 1.703(a)(3) is not warranted for Office delay in responding to the April 10, 2009 reply if:

- (1) An Office action issued within four months of applicant filing the April 10, 2009 reply, and
- (2) The Office action was an “action under 35 U.S.C. 132.”

With respect to requirement (1) above, the June 25, 2009 Office action was clearly mailed within four months of applicant filing the April 10, 2009 reply.

With respect to requirement (2) above, the June 25, 2009 Office action was an “action under 35 U.S.C. 132.”

35 U.S.C. 132(a) states,

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application....

The June 25, 2009 Office action satisfied the criteria set forth in 35 U.S.C. § 132. The Office action:

- (1) Followed examination of the application by the examiner,
- (2) Included the rejection of more than one claim,
- (3) Notified applicant of the reasons for the rejection of the claims, and
- (4) Provided applicant with information and references as may be useful in judging the propriety of continuing prosecution of the application.

Since the June 25, 2009 Office action satisfied all the criteria set forth above, the Office action was an action under 35 U.S.C. § 132.

In view of the prior discussion, an adjustment under 35 U.S.C. § 154(b)(1)(A)(ii) and 37 C.F.R. § 1.703(a)(3) for delay in responding to the April 10, 2009 reply is unwarranted.

The patent term adjustment at the time of mailing of the notice of allowance remains 1,095 days.

Submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged. No additional fee is required.

Applicant is reminded any delays by the Office pursuant to 37 C.F.R. §§ 1.702(a)(4) and 1.702(b) and any applicant delays under 37 C.F.R. §1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicant approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is positioned above the printed name.

Anthony Knight
Director
Office of Petitions